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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,862	11/26/2003	James D. Bindford	BINFD-001A	8603

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EXAMINER
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JOHNSON, JERROLD D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/722,862	Applicant(s) BINDFORD, JAMES D.	
	Examiner Jerrold Johnson	Art Unit 3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                   |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a medication dispenser classified in class 206, subclass 534.
- II. Claims 14-21, drawn to a medication compliance and management method, classified in class 424, subclass n/a.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as the filling and dispensing of the product by the user.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kit Stetina on January 06/05 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 14-21 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

#### **DETAILED ACTION**

The drawings are objected to under 37 CFR 1.83(a) because:

the drawings fail to show the adhesive on both sides of the membrane 112 as described in the specification.

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

It is believed that the adhesive on the membrane which allows the attachment of the membrane to the backing 114 and also allows the attachment of the membrane to the front layer 116 is essential to the construction of the invention. It is also believed that this construction, along with the protective layer 118 will likely be necessary to define the invention over the prior art. Accordingly, this entire construction, including the adhesive layers, should be shown.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: the recitation "the pills within only one compartment being removable" is confusing. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2 and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson, US 6,550,618.

Peterson discloses a medication dispenser for maintaining a patient's compliance with a pharmaceutical regimen, the pharmaceutical regimen setting forth a consumption requirement of pills, the dispenser comprising a plurality of compartments filled with respective pills uniquely arranged and organized with respect to time to reduce a complexity of the pharmaceutical regimen, the pills within only one compartment being removable; and an indicia flap 15 adjacent to the compartments (Fig. 1, Fig. 5) having information with respect to the pills.

With respect to claim 2, the compartments have a box configuration.

With respect to claim 9, the information relates to identification of the pills.

With respect to claim 10, the identification of the pills is through a graphical image of the pill.

With respect to claim 11, the graphical image of the pill may be in a form selected from the group consisting of black and white photograph, color photograph, sketch, identifying marks, pharmaceutical name, trade name and combinations thereof.

With respect to claim 12, the information relates to directions to consume the pills.

With respect to claim 13, the information relates to warnings of the pills.

See column 2 of the Peterson patent for the recitations drawn to the information on the indicia flap.

Additionally, although the contents of the information on the indicia flap are disclosed by Peterson, the recitations in the claims drawn to the contents of the information is construed as intended use only, and does not impart structural limitations on these claims.

Reference is made to the following two Federal Circuit decisions: *In re Gulack*, 703 F.2d. 1381 [217 USPQ 401] (Fed. Cir. 1983), and *In re Ngai* 70 USPQ 2d 1862 (CA FC 2004).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson, US 6,550,618, in view of Bouthiette, US 5,788,079.

Peterson does not explicitly disclose the limitation of claims 3-8.

Bouthiette discloses a dispenser of which:

with respect to claim 3, the compartments are transparent from an open front position of the dispenser;

with respect to claim 4, the compartments are compressible;

with respect to claim 5, at least some of the compartments are defined by a penetrable membrane such that pressing on the compartment will extract the pills of the pressed compartment only;

with respect to claim 6, the compartments are arranged by time of day;

with respect to claim 7, the compartments are further arranged by day of week; and

with respect to claim 8, the compartments are attached to a pill flap

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and the pill flap has perforations grouping the compartments for a single days supply of pills to make the pills to be consumed that day convenient to carry by the patient.

See Fig. 4, in particular.

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the dispenser of Peterson with the dispenser, as taught by Bouthiette, as the blister pack arrangement taught by Bouthiette is known for its ease of use, in particular with respect to tearing away individual doses or multiple doses for later consumption.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jdj

A handwritten signature in black ink, appearing to read "Mickey Yu", with a long horizontal stroke extending to the right.

Mickey Yu  
Supervisory Patent Examiner  
Group 3700